

03-01-

AA

Docket No. P-6335.01CIP

02/29/00
jc760 U.S. PTO

TO: Box PATENT APPLICATION
Commissioner of Patents and Trademarks
Washington, D.C. 20231

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of

INVENTOR(S)	Nora Aghassi Kim Franceschini Paul J. Ardi
TITLE OF INVENTION	COMPOSITION AND METHOD FOR TREATING TISSUE SAMPLES

jc713 U.S. PTO
09/515283
02/29/00

WARNING: Patent must be applied for in the name(s) of all of the actual inventor(s). 37 CFR 1.41(a) and 1.53(b).

1. Type of Application:

This new application is for a(n):

- ☒ Original
☐ Design
☐ Plant

WARNING: Do not use this transmittal for a completion in the U.S. of an International Application under 35 U.S.C. 371(c)(4) unless the International Application is being filed as a divisional, continuation, or continuation-in-part application.

NOTE: If one of the following 3 items apply, then complete and attach "Added Pages for New Application Transmittal Where Benefit of a Prior U.S. Application Claimed" and a "Notification in Parent Application of the Filing of this Continuation Application".

- ☐ Divisional
☐ Continuation
☒ Continuation-in-part (CIP)

2. Benefit of Prior U.S. Application(s) (35 USC §120):

NOTE: If the new application being transmitted is a divisional, continuation, or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., then check the following item and complete and attach "Added Pages For New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed".

- ☒ The new application being transmitted claims the benefit of prior U.S. application(s) and enclosed are "Added Pages For New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed".

3. Papers Enclosed Which Are Required For Filing Date Under 37 CFR §1.53(b) (Regular) or 37 CFR §1.153 (Design) Application:

24 Pages of specifications
3 Pages of claims

The PTO did not receive the following listed item(s) a check. \$ 345

WARNING: Do not submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. Comments on proposed new 37 CFR 1.84, Notice of March 9, 1988 (1990 O.G. 57-62).

NOTE: "Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm (5/8 inch) down from the top of the page." 37 CFR 1.84(c).

(Complete the following, if applicable.)

☐ The enclosed drawing(s) are photograph(s), and there is also attached a "Petition to Accept Photograph(s) as Drawing(s)". 37 CFR 1.84(b).

4. Additional papers enclosed:

- ☐ Preliminary Amendment
- ☐ Information Disclosure Statement
- ☐ Form PTO-1449
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☒ Other, Request for Extension of Time being filed for the parent application Serial No. 08/957,098, filed October 24, 1997.

5. Declaration or oath:

- ☐ Enclosed, executed by
 - ☐ Inventor(s).
 - ☐ Legal representative of inventor(s). 37 CFR §1.42 OR §1.43
 - ☐ Joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.
 - ☐ This is the petition required by 37 CFR §1.47 and the statement required by 37 CFR §1.47 is also attached.
- ☒ Not Enclosed.

WARNING: Where the filing is a completion in the U.S. of an International Application but where a declaration is not available or where the completion of the U.S. application contains subject matter in addition to the International Application, the application may be treated as a continuation or continuation-in-part, as the case may be, utilizing "Added Page for New Application Transmittal Where Benefit of Prior U.S. Application Claimed".

- ☒ Application is made by a person authorized under 37 CFR §1.41(c) on behalf of all the above named inventor(s). The declaration or oath, along with the surcharge required by 37 CFR §1.16(e) can be filed subsequently.

NOTE: It is important that all of the correct inventor(s) are named for filing under 37 CFR 1.41(c) and 1.53(b).

- ☐ Showing that the filing is authorized. (Not required unless called into question.) 37 CFR 1.41(d).

6. **Inventorship Statement:**

WARNING: If the named inventors are each not the inventors of all the claims, an explanation, including the ownership of the various claims at the time the last claimed invention was made, should be submitted.

The inventorship for all the claims in this application are:

- ☐ The same
☒ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made:
☐ Is submitted.
☒ Will be submitted.

7. **Language:**

NOTE: An application including a signed oath or declaration may be filed in a language other than English. A verified English translation of the non-English language application and the processing fee of \$130.00 required by 37 CFR 1.17(k) is required to be filed with the application or within such time as may be set by the Office. 37 CFR 1.52(d).

NOTE: A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 CFR 1.69(b).

- ☒ English
☐ Non-English
☐ The attached translation is a verified translation. 37 CFR 1.52(d).
☐ Additional fee of \$130.00 is attached.

8. **Assignment:**

- ☒ An assignment of the invention to **COMPOSITION AND METHOD FOR TREATING TISSUE SAMPLES:**
☐ Is attached. A separate:
☐ Cover Sheet for Assignment (Document) Accompanying New Patent Application,
or
☐ Form PTO
is also attached.
☒ Will follow.

NOTE: If an assignment is submitted with a new application, send two separate letters, one for the application and one for the assignment. Notice of May 4, 1990 (1114 O.G. 77-78).

WARNING: A newly executed "Certificate Under 37 CFR 3.73(b)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.

9. **Certified Copy:**

Certified copy(ies) of application(s)

<u>COUNTRY</u>	<u>APPLN. NO.</u>	<u>FILED</u>
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_____	_____	_____
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from which priority is claimed:

- ☐ Is (are) attached.
☐ Will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 CFR 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application, then complete Item 18 on the "Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed".

10. **Fee Calculation (37 CFR §1.16):**

A. ☐ **Regular application**

CLAIMS AS FILED			
NUMBER FILED	NUMBER EXTRA	RATE	BASIC FEE 37 CFR 1.16(a) \$690.00
Total Claims (37 CFR 1.16(c))	X-20=X	\$18.00	
Independent Claims (37 CFR 1.16(b))	X-3=X	\$78.00	
Multiple dependent claim(s), if any (37 CFR 1.16(d))	X	\$260.00	

- ☐ Amendment canceling extra claims enclosed.
☐ Amendment deleting multiple dependencies enclosed.
☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims canceled by amendment prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 CFR 1.16(d).

Filing Fee Calculation \$690.00

B. ☐ **Design application**
(\$310.00--37 CFR §1.16(f))

Filing Fee Calculation \$_____

C. ☐ **Plant application**
(\$480.00--37 CFR §1.16(g))

Filing Fee Calculation \$_____

11. **Small Entity Statement(s):**

- ☒ Verified Statement(s) that this is a filing by a small entity under 37 CFR §1.9 and §1.27 is(are) attached.

Filing Fee Calculation \$345.00
(50% of A,B,or C above)

NOTE: Any excess of the full fee paid will be refunded if a verified statement and a refund request are filed within 2 months of the date of timely payment of a full fee. 37 CFR 1.28(a).

12. **Request for International-Type Search (37 CFR §1.104(d)):**

- ☐ Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

13. Fee Payment Being Made At This Time:

- ☐ Not Enclosed
- ☐ No filing fee is to be paid at this time. (This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently.)
- ☒ Enclosed
- | | |
|--|------------------|
| <input type="checkbox"/> Basic filing fee | \$ <u>345.00</u> |
| <input type="checkbox"/> Recording assignment (\$40.00; 37 CFR §1.21(h)) | \$ _____ |
| <input type="checkbox"/> Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached. (\$130.00; CFR §1.47 and §1.17(h)) | \$ _____ |
| <input type="checkbox"/> For processing an application with a specification in a non-English language. (\$130.00; 37 CFR §1.52(d) and §1.17(k)) | \$ _____ |
| <input type="checkbox"/> Processing and retention fee (\$130.00; 37 CFR §1.53(d) and §1.21(l)) | \$ _____ |
| <input type="checkbox"/> Fee for international-type search report (\$1,250; 37 CFR §1.21(e)) | \$ _____ |
| Total fees enclosed | \$ <u>345.00</u> |

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as the changes to 37 CFR 1.53 and 1.78, indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be paid or the processing and retention fee of § 1.21(l) must be paid within 1 year from notification under § 53(d).

14. Method of Payment of Fees:

- ☒ Check in amount of \$345.00.
- ☐ Charge Account No. 07-2400 in the amount of \$____. A duplicate of this transmittal is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 CFR 1.22(b).

15. Authorization to Charge Additional Fees:

WARNING: If no fees are to be paid on filing, the following items should not be completed.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

- ☒ The Commissioner is hereby authorized to charge the following additional fees by this paper during the entire pendency of this application to Account No. 07-2400.
- ☒ 37 CFR §1.16 (a), (f) or (g) (filing fees)
- ☒ 37 CFR §1.16 (b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- ☒ 37 CFR §1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 CFR §1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under § 1.136(a), this authorization should be made only with the knowledge that "Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a request or petition for extension is filed." (Emphasis added). Notice of November 5, 1985 (1060 O.G. 27).

☐ 37 CFR §1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR §1.311(b))

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application...prior to paying, or at the time of paying,...issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity", and (b) no notification is required if the change is to another small entity.

16. Instructions As To Overpayment:

☒ Credit Account No. 07-2400
☐ Refund



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☒ **Incorporation by reference of added pages**

(Check the following item if the application in this transmittal claims the benefit of prior U.S. application(s) (including an international application entering the U.S. stage as a continuation, divisional, or CIP application) and complete and attach the "Added Pages for New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed".)

☒ Plus Added Pages For New Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed

Number of pages added 2

☒ Plus Added Pages for Papers Referred To In Item(s) 4, ____ Above

Number of pages added 3

☐ **Statement Where No Further Pages Added**

(If no further pages form a part of this Transmittal, then end this Transmittal with this page and check the following item.)

☐ This transmittal ends with this page.

CERTIFICATE OF MAILING

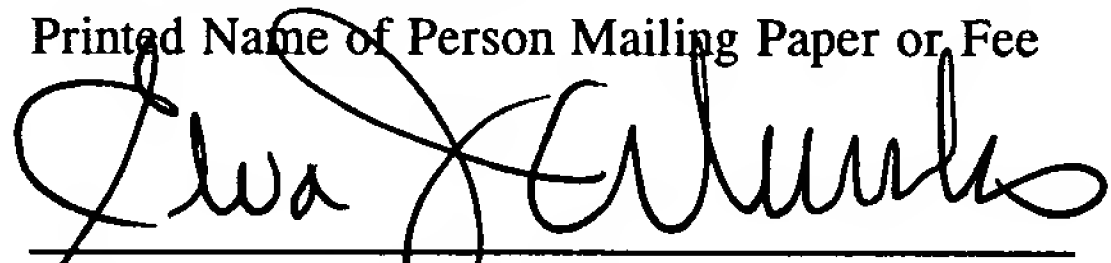
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being

deposited on the date shown below with the United States Postal Service in an envelope addressed to the
"Commissioner of Patents and Trademarks, Washington, D.C. 20231", as follows:

<p style="text-align: center;"><u>37 CFR 1.8(a)</u></p> <p><input type="checkbox"/> With sufficient postage as First Class Mail.</p> <p>Date: _____, 19__</p>	<p style="text-align: center;"><u>37 CFR 1.10</u></p> <p><input type="checkbox"/> As "Express Mail Post Office to Addressee", Mailing Label No. EL510302 707US</p> <p>Date: 2/29/00</p>
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ELVA J. Abundis

Printed Name of Person Mailing Paper or Fee



Signature of Person Mailing Paper or Fee

**ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF
PRIOR U.S. APPLICATION(S) CLAIMED**

17. Relate Back - 35 U.S.C. §120:

☐ Amend the Specification by inserting before the first line the sentence:

"This is a:

- ☐ Continuation
☒ Continuation-in-part
☐ Divisional

of co-pending application(s)

☒ Serial number 08/957,098 filed on 10/24/97.

☐ International Application No. _____ filed on __/__/__ and which designated the U.S.

18. Relate Back - 35 U.S.C. 119 Priority Claim for Prior Application:

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17, in turn itself claim(s) foreign priority(ies) as follows:

<u>COUNTRY</u>	<u>APPL. NO.</u>	<u>FILED</u>
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The certified copy(ies) has (have):

- ☐ Been filed on __/__/__ in prior application No. __/__, which was filed on __/__/__.
☐ Is (are) attached

19. Maintenance of Copendency of Prior Application:

- A. ☒ Extension of time in prior application.
☐ A petition, fee and response extends the term in the pending **prior** application until __/__/__.
☒ A **copy** of the petition filed in prior application is attached.
☐ No action has been taken in prior application
- B. ☐ Conditional Petition for Extension of Time in Prior Application.
☐ A conditional petition for extension of time is being filed in the pending **prior** application.
☐ A **copy** of the conditional petition filed in the prior application is attached.

20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed:

- (a) ☐ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are:
☐ The same.
☐ Less than those named in the prior application and it is requested that the following inventor(s) identified for the prior application be deleted: _____.

(b) ☒ This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application the inventor(s) in this application are

☒ The same.

☐ The following additional inventor(s) have been added: _____.

(c) The inventorship for all the claims in this application are:

☐ The same.

☒ Not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made:

☐ Is submitted.

☒ Will be submitted.

21. **Abandonment of Prior Application (if applicable):**

☒ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

22. **Petition for Suspension of Prosecution for the Time Necessary to File an Amendment:**

☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

23. **Notification in Parent Application of This Filing:**

☐ A notification of the filing of this:

☐ Continuation

☒ Continuation-in-part

☐ Divisional

is being filed in the parent application from which this application claims priority under 35 U.S.C. § 120.

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